



Attorney's Do. No. 5868-4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: Mark T. Wajer, et al

Serial No. 09/769,761

Group Art Unit: 1731

Filing Date: January 26, 2001

Examiner: S. Alvo

For: PROCESS EMPLOYING MAGNESIUM HYDROXIDE IN
PEROXIDE BLEACHING OF MECHANICAL PULP

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AUG 29 2002

TC 1700

Assistant Commissioner for Patents
Washington, D.C. 20231

DECLARATION TO OVERCOME A CITED PUBLICATION (37 C.F.R. 1.131)

1. This declaration is to establish the prior invention in patent applications Provisional 60/178,704, filed January 28, 2000 ("Provisional I"), and Provisional 60/207,205, filed May 26, 2000 ("Provisional II"), the parent patent applications of the above-reference patent application U.S. Serial No. 09/769,761 ("Application"), in the United States, at a date prior to January 21, 2000, the Critical Date ("Critical Date") with respect to the prior art publication CA 2,278,399 that was cited by the Examiner.
2. The persons making this Declaration are Mark T. Wajer ("Wajer"), Business Development Manager, and Aileen Gibson ("Gibson"), Product Development Manager, for Martin Marietta Magnesia Specialties ("MMMS").
3. Wajer and Gibson are the co-inventors in the Application. MMMS is the assignee of the Application.

4. The University of Maine ("UM"), located in Orono, Maine, was contacted by Gibson, prior to the Critical Date, regarding MMMS funding a study on the use of magnesium hydroxide in the bleaching of mechanical pulp at the Pulp and Paper Process Development Center ("PDC"), at the University of Maine ("UM"), located in Orono, Maine.
5. Prior to the Critical Date, UM agreed to conduct a multi-phase testing program ("Testing Program") for MMMS at the PDC directed to peroxide bleaching of mechanical pulp using magnesium hydroxide as a replacement for various pulp bleaching chemicals.
6. The first phase of the Test Program was performed at the PDC substantially continuously during a time period beginning and ending prior to the Critical Date, without having been halted or abandoned for other research projects, lack of funding or personnel, or other administrative or financial reasons.
7. A report setting forth the results of the first phase of the Test Program ("Report 1"), a copy of which is attached hereto as Exhibit "A", was issued to MMMS by UM on January 6, 2000.
8. Prior to the Critical Date, Gibson prepared a written document based on Report 1 ("Document 1") which was employed in drafting Provisional I.
9. Provisional I was prepared on behalf of MMMS by the law firm of McDermott, Will & Emery based on Report 1 and Document 1.
10. The second phase of the Test Program was performed at the PDC substantially continuously during a time period beginning at the end of the first phase of the Test Program, and ending subsequent to the Critical Date, without having been halted or abandoned for other research projects, lack of funding or personnel, or other administrative or financial reasons.

11. A report setting forth the results of the second phase of the Test Program ("Report 2"), a copy of which is attached hereto as Exhibit "B", was issued to MMMS by UM on May 18, 2000.
12. Gibson prepared a written document based on Report 2 ("Document 2") which was employed in drafting Provisional II.
13. Provisional II was prepared on behalf of MMMS by the law firm of McDermott, Will & Emery based on Report 2 and Document 2.
14. The Test Program conducted at the PDC was funded entirely by MMMS.

We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Inventor: Mark T. Wajer

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Inventor's signature Aileen R. Gibson Date Aug 20, 2002
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MJM Do. No. 5868-4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Serial No. 09/769,761 Group Art Unit: 3796
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Assistant Commissioner for Patents
Washington, D.C. 20231

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DECLARATION TO OVERCOME A CITED PUBLICATION (37 C.F.R. 1.131)

Joseph M. Genco, Ph.D., declare as follows:

1. This declaration is to establish the prior invention in patent applications Provisional 60/178,704, filed January 28, 2000 ("Provisional I"), and Provisional 60/207,205, filed May 26, 2000 ("Provisional II"), the parent patent applications of the above-reference patent application U.S. Serial No. 09/769,761 ("Application"), in the United States, at a date prior to January 21, 2000, the Critical Date ("Critical Date") with respect to the prior art publication CA 2,278,399 that was cited by the Examiner.

2. The person making this Declaration is a Professor of Chemical Engineering, and the Director of the Pulp and Paper Process Development Center ("PDC"), at the University of Maine ("UM"), located in Orono, Maine.

3. UM was contacted by Aileen Gibson ("Gibson") and Mark T. Wajer ("Wajer") of Martin Marietta Magnesia Specialties ("MMMS"), prior to the Critical Date, regarding MMMS funding a study on the use of magnesium hydroxide in the bleaching of mechanical pulp.

4. Prior to the Critical Date, UM agreed to conduct a multi-phase testing program ("Testing Program") for MMMS at the PDC directed to peroxide bleaching of mechanical pulp using magnesium hydroxide as a replacement for various pulp bleaching chemicals.

5. The first phase of the Test Program was performed at the PDC substantially continuously during a time period beginning and ending prior to the Critical Date, without having been halted or abandoned for other research projects, lack of funding or personnel, or other administrative or financial reasons.

6. A report setting forth the results of the first phase of the Test Program, a copy of which is attached hereto as Exhibit "A", was issued to MMMS by UM on January 6, 2000.

7. The second phase of the Test Program was performed at the PDC substantially continuously during a time period beginning at the end of the first phase of the Test Program and ending subsequent to the Critical Date, without having been halted or abandoned for other research projects, lack of funding or personnel, or other administrative or financial reasons.

8. A report setting forth the results of the second phase of the Test Program ("Report 2"), a copy of which is attached hereto as Exhibit "B", was issued to MMMS by UM on May 8, 2000.

9. The Test Program conducted at the PDC has been funded entirely by MMMS.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date:

Aug 27, 2002

Joseph M. Genco
Joseph M. Genco, Ph.D.